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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,930	09/04/2003	Geoffrey B. Rhoads	P0877	8366

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DIGIMARC CORPORATION
9405 SW GEMINI DRIVE
BEAVERTON, OR 97008

EXAMINER

PERUNGAVOOR, VENKATANARAY

ART UNIT	PAPER NUMBER
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2132

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/28/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/656,930

Applicant(s)

RHOADS ET AL.

Examiner

Venkat Perungavoor

Art Unit

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claim 4 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claim recites authentication information being based on semantic information, and further a semantic information reader. The Examiner cannot find support for these in the specification and the term is not known commonly in the art. The Applicant is asked to amend the claim, to consistent with specifications or to indicate where in the specifications the information can be found.
2. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Applicant mentions the authentication information reader to process the first authentication information and the security pattern to produce the read first authentication information, which is not understood by the Examiner. Furthermore, there is an antecedent basis issue with "the read first authentication information".

Specification

3. The abstract of the disclosure is objected to because it is not descriptive of the invention. The abstract is misrepresented as it does not clearly disclose the invention, but speaks broadly to the watermarking and authentication. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3, 5-8, 10-15, 17-20 are rejected under 35 U.S.C. 102(a) as being anticipated by EP0650146 A1 to Eastman Kodak Company(Kodak) in view of US Patent 5613004 to Cooperman et al.(hereinafter Cooperman).
6. Regarding Claim 1, 20, 11, 18, Kodak discloses the storage system which stores the second authentication information see Fig. 1 item 30; a processor having an information reader see item 20; and processor to retrieve second authentication information see item 50, 80 and read the first authentication information and compare with second authentication information to determine authenticity see Abstract & Col 5 Ln 22-Col 6 Ln 10. But does not discloses the embedding of first information. However, Cooperman discloses the embedding of first information see Col 5 Ln 30-48. It would be obvious to one having ordinary skill in

the art at the time of the invention to include in the invention of watermarking/embedding in order to make it visually imperceptible see Col 5 Ln 60-66.

7. Regarding Claim 2, 13, Kodak discloses the algorithm being chosen and embedded within the table and used with the code to check authenticity see Col 5 Ln 34-58.
8. Regarding Claim 3, 15, Kodak discloses the validation requestor identification² code being sent to CAA to obtain other codes and for storage see Col 3 Ln 21-34.
9. Regarding Claim 5, Kodak discloses the authenticity of the code being verified to the source see Fig. 1 item 90.
10. Regarding Claim 6, Kodak discloses the digitalizing of photos see Col 3 Ln 3-7.
11. Regarding Claim 7, Kodak pre-approval code being used and the algorithm is being used to be verified with CAA and the card see Col 6 Ln 58- Col 7 Ln 4.
12. Regarding Claim 8, 14, Kodak discloses the PIN number being inputted by the user see Col 7 Ln 20-25.

13. Regarding Claim 10, Kodak discloses the plurality of devices and routing codes see Col 6 Ln 23-39.
14. Regarding Claim 12, Kodak discloses the digitalizing of photos see Col 3 Ln 3-7; further discloses the storage system which stores the second authentication information. see Fig. 1 item 30; a processor having an information reader see item 20; and processor to retrieve second authentication information see item 50, 80 and read the first authentication information and compare with second authentication information to determine authenticity see Abstract & Col 5 Ln 22- Col 6 Ln 10. But does not discloses the embedding of first information. However, Cooperman discloses the embedding of first information see Col 5 Ln 30-48. It would be obvious to one having ordinary skill in the art at the time of the invention to include in the invention of watermarking/embedding in order to make it visually imperceptible see Col 5 Ln 60-65.
15. Regarding Claim 17, Kodak discloses the verification of visual aspects see Col 1 Ln 55- Col 2 Ln 16.
16. Regarding Claim 19, Kodak discloses the photo ID see Col 2 Ln 16-19, photo being scanned in photo software see Col 4 Ln 31-33, and the tagging of photos see Col 4 Ln 34-38.

17. Claims 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP0650146 A1 to Eastman Kodak Company(Kodak) in view in view of US Patent 5613004 to Cooperman et al.(hereinafter Cooperman) further in view of US Patent 5467447 to Vogel.
18. Regarding Claim 9, Kodak discloses the authentication of read information see Abstract. But does not explicitly disclose analog form containing a security pattern and associating the pattern with digital representation. However, Vogel disclose the analog form containing a security pattern see Fig. 1 item 5 and 6 and associating the pattern with digital representation see Fig. 11 item 24. It would be obvious to one having ordinary skill in the art at the time of the invention to include the analog form containing a security pattern and associating the pattern with digital representation in the invention of Kodak in order to further improve security by an texture feature see Col 3 Ln 20-30.
19. Claims 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP0650146 A1 to Eastman Kodak Company(Kodak) in view of US Patent 5475205 to Behm et al.(hereinafter Behm).
20. Regarding Claim 16, Kodak does not disclose the locating of authentication information. However, Behm discloses the locating of the information on the document and checking for authenticity see Abstract & Col 6 Ln 15-24. It would

be obvious to one having ordinary skill in the art at the time of the invention to include the information on the document and checking for authenticity in the invention of Kodak in order to have defined portion dedicated to authentication information see Col 5 Ln 13-26.

Conclusion


21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Venkat Perungavoor whose telephone number is 571-272-7213. The examiner can normally be reached on 8:30-5:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.
22. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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VP
2/26/07

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Examiner
Art Unit 2132


Benjamin E. Lanier
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